

Amendment and Response Under 37 C.F.R. 1.116

Applicant: Peter J. Fritz

Serial No.: 10/081,794

Filed: February 21, 2002

Docket No.: M120.169.103 (54666US006)

Title: METHOD FOR ATTACHING A FASTENER TO A SURFACE TREATING MEMBER, AND SUCH AN ARTICLE HAVING A FASTENER

REMARKS

This is responsive to the Final Office Action mailed January 25, 2005. In that Office Action, the Examiner rejected claims 31-40 and 43-52 under 35 U.S.C. § 103(a) as being unpatentable over Johnson et al., U.S. Patent No. 3,562,968 ("Johnson") in view of Gugle et al., U.S. Patent No. 4,636,124 ("Gugle").

Claims 31-40, 43-52 remain pending in the application and are presented for reconsideration and allowance. Newly added claim 53 is offered for entry, consideration, and allowance.

Support for Newly Added Claim 53

The Applicant believes that Fig. 4, for example, provides support for newly added claim 53.

35 U.S.C. § 103 Rejections

The Examiner rejected claim 31 under 35 U.S.C. § 103(a) as being unpatentable over Johnson in view of Gugle. Claim 31 relates, in part, to a method for attaching a fastener to a surface conditioning member by inducing relative rotation between the fastener and the surface conditioning member with a layer of thermoplastic adhesive in contact with a planar surface of the fastener and the surface conditioning member, so as to soften the layer of adhesive to form a bond between the fastener and the surface conditioning member. The method also includes stopping the relative rotation between the fastener and the surface conditioning member. For at least the reasons described below, it is believed that the cited references fail to teach or suggest such limitations.

It is respectfully asserted that rather than citing specific motivation to combine the cited references, the Examiner has improperly relied on a theory that the references could be combined. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the

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combination.” MPEP § 2143.01 (citing *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)) (emphasis added).

In the Office Action, the Examiner appears to agree with and address Applicant’s previously submitted argument that there would be no motivation to modify Johnson, as none of the cited references teach or suggest that spin welding “provide[s] a more secure connection” (identified by the Examiner in an earlier Office Action mailed August 25, 2004 as being a motivation to combine). In particular, in the current Office Action, the Examiner states that “it should be noted that providing a more secure connection between the fastener and the surface conditioning member [of Johnson] would only be one of several motivations for combining the references.” OA 1-25-05 at 2. However, the Examiner does not describe any other motivations. It is respectfully argued that the Examiner’s burden cannot be satisfied by bare reference to several unidentified “motivations” that might exist.

Further, the Examiner argues that the fact that there is no motivation to provide a more secure connection, “does not remove the fact that Gugle et al merely disclose using a frictional weld as a method for attaching two members together.” OA 1-25-05 at 2-3. Regardless of whether Gugle discloses friction-welding, there must be some motivation to combine Gugle with Johnson. The fact that Gugle discloses friction welding does not mean one having ordinary skill in the art would combine such a teaching with Johnson. It is respectfully believed that the Examiner’s position that Gugle can, in theory, be combined with Johnson fails to provide any requisite motivation to combine. Thus, it is respectfully presented that the Examiner has failed to present a *prima facie* case of obviousness as it is improper to combine references when they simply can be combined, and no specific motivation for such a combination has been provided.

In replying to the Applicant’s argument that Gugle teaches away from a fastener having a planar surface, the Examiner indicates “even though the weld surface 28 is angled relative to the horizontal, it is still somewhat planar; the plane being at an angle to the horizontal.” OA 1-25-05 at 3. However, the Examiner is regarding the friction weld surface 28 in two-dimensional terms, as shown in cross-section in Fig. 1 of Gugle. When properly viewed in three-dimensional terms as embodied, rather than two-dimensional terms, it is clear that the friction weld surface 28 is

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actually conical in shape, and not planar as interpreted by the Examiner. With this clarification, Gugle, in fact, teaches away from a layer of thermoplastic adhesive in contact with a planar surface of a fastener in contrast to the limitations of claim 31. Therefore, one of ordinary skill in the art is taught away from combining the method as taught by Gugle with any planar structure that might otherwise be taught by Johnson.

In light of these clarifications, it is believed that none of the cited references, either individually or in combination, teach or suggest limitations of claim 31. As claims 32-40 and 43-52 depend in some form from claim 31, it is believed that they are patentably distinct from the cited references for reasons similar to those outlined above. As such, the Examiner's rejection is respectfully traversed. It is requested that the Examiner's rejection of claims 31-40 and 43-52 be withdrawn with allowance of those claims and notice to that effect provided.

Newly added claim 53 also depends from independent claim 31. Therefore, it is believed allowable similarly to the dependent claims mentioned above. Additionally, claim 53 incorporates limitations cited by the Examiner as patentably distinct from the cited references. In particular, at page 3, the Examiner notes the "Applicant only recites a planar surface, and not a surface that is planar and parallel to the surface conditioning member." Therefore, it is believed that newly added claim 53 is further distinguishable from the cited references by incorporating such a limitation. As such, it is respectfully requested that the Examiner enter the Applicant's Amendment, with allowance of claim 53 and notice to that effect provided.

CONCLUSION

In view of the above, Applicant respectfully submits that pending claims 31-40 and 43-53 are in form for allowance and are not taught or suggested by the cited references. Therefore, reconsideration and withdrawal of the claim rejections and allowance of claims 31-40 and 43-53 is respectfully requested.

No fees are required under 37 C.F.R. 1.16(b)(c). However, if such fees are required, the Patent Office is hereby authorized to charge Deposit Account No. 50-0471.

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The Examiner is invited to contact the Applicant's representative at the below-listed telephone numbers to facilitate prosecution of this application.

Any inquiry regarding this Amendment and Response should be directed to either Melissa E. Buss at Telephone No. (651) 733-0649, Facsimile No. (651) 736-3833, or Timothy A. Czaja at Telephone No. (612) 573-2004, Facsimile No. (612) 573-2005. In addition, all correspondence should continue to be directed to the following address:

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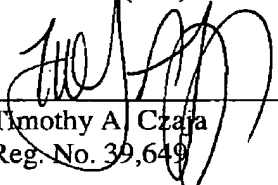
Respectfully submitted,

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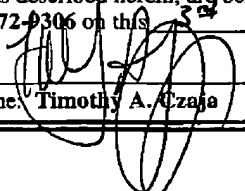
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CERTIFICATE UNDER 37 C.F.R. 1.8:

The undersigned hereby certifies that this paper or papers, as described herein, are being transmitted via telefacsimile to Examiner Eley, Group Art Unit 3724, at Fax No. (703) 872-9306 on this 3rd day of March, 2005.

By 
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